

CURTIN Declaration

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
Rabbani et al.
Application No. 08/978,632
Filed: November 25, 1997
Atty Docket No. ENZ-53(C)

OFFICE OF PETITIONS
Ms. Nancy Johnson
Senior Petitions Attorney
Confirmation No.: 4638

MAIL STOP PETITION Commissioner
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Alexandria, VA 22313-1450

**DECLARATION BY LISA CURTIN IN SUPPORT OF PETITION FOR
RECONSIDERATION OF THE ORDER TO SHOW CAUSE**

Mail Stop PETITION
Commissioner for Patents
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I, Lisa Curtin, provide this Declaration to answer some of the questions raised by the United States Patent and Trademark Office ("USPTO") in the Order to Show Cause issued June 2009 ("the Order") as well as in a number of Decisions rendered by the USPTO on Petitions filed in response to earlier issued Orders to Show Cause.

I am a U.S. citizen, of legal age, and a resident of Queens, New York. I am making the statements in this Declaration based on my own personal knowledge and belief. Where I have referred to or relied upon documents in making any of my statements, they are documents that I have personal knowledge of based on my recollection and past experience, and/or have reviewed in connection with preparing this Declaration.

1. I am currently employed by Enzo Biochem, Inc. ("Enzo") as a paralegal.
2. I started my employment with Enzo on a part time basis in January 1993. Ronald C. Fedus, Esq., Enzo's Patent and Corporation Counsel, engaged me at that time in order to provide paralegal litigation support services in connection with an ongoing litigation in which Enzo was involved. On January 1, 1994, I became a full-time employee of Enzo.
3. Over the years my duties at Enzo have been to provide assistance to counsel, corporate officers and marketing and sales executives in all legal matters and in all areas of the corporation's business, including Enzo's subsidiaries.
4. Prior to my employment with Enzo, I was employed by Lieberman & Nowak, LLP as a paralegal from January 1990 through December 1992.
5. I graduated from the Bronx High School of Science in 1970, and from Herbert H. Lehman College of the City University of New York in 1974 with a BA in English. I graduated in June of 1993 from New York University's Institute For Paralegal Studies, which program is fully accredited by the American Bar Association. I am not an attorney.
6. I have read the Order and I understand that the USPTO is requiring an explanation of Enzo's docketing practices and procedures in responding to Office communications, such as Office Actions and Notices of Abandonment from December 23, 1992 through November 29 2005. I am familiar with Enzo's docketing procedures during the time I had that responsibility which is from about June 1997 through about April 2003.

7. When I started working part time for Enzo in January of 1993, Enzo was located at 575 Fifth Avenue, New York, New York 10017. At that time, most of the work relating to patent prosecution was done by Ronald C. Fedus, Esq., Enzo's sole in-house attorney.

8. In June of 1996 Enzo moved its Manhattan corporate offices from 575 Fifth Avenue, New York, New York, 10017 to 527 Madison Avenue, New York, New York 10022

9. Sometime around June of 1997, I created a Microsoft Word table document in order to serve as an electronic calendar for keeping track of patent prosecution matters and which table could be used as a docketing tool.

10. At the time I began to docket prosecution matters, the legal department's secretary would place documents that needed to be docketed, such as Official Communications, including Office Actions, and the like, into a wire basket which was located in a central location easily accessible to employees. At least as often as twice a month, and often as frequently as weekly, I would review each document in the basket in order to ascertain various dates on which matters needed to be attended to. I would hand-write those dates and the actions associated with and/or required on those dates onto a legal pad in chronological order, by individual matter. I would then give the pad to the legal department's secretary who would then type my handwritten entries into the Microsoft Word table document (hereinafter the "Table Docket"), which consisted of monthly page(s) by year, i.e., June 1997, July 1997, August 1997, etc. Each of these monthly page(s) constituted a docket in and of itself ("Docket Reports"). Office Actions were docketed for reply at monthly intervals for every month going forward from the date the Office Action issued, up to six months following the Office Action issue date. As an example, if I had before me for docketing a Non-Final Office Action ("the NF OA") dated September 1, 1993 in connection

with patent application ABC ("ABC"), I would docket: 1) the date of issuance of the NF OA as September 1, 1993; and 2) I would docket October 1, 1993 as one (1) month after the NF OA issued in connection with ABC; 3) November 1, 1993 as two (2) months after the NF OA issued in connection with ABC; 4) December 1, 1993 as three (3) months after the NF OA issued in connection with ABC; 5) January 1, 1994 as four (4) months after the NF OA issued in connection with ABC; 6) February 1, 1994 as five (5) months after the NF OA issued in connection with ABC; and 7) March 1, 1994 as six (6) months after the NF OA issued in connection with ABC. After the legal department secretary typed my docket entries into the Table Docket, she would hand me a printout of the Table Docket, and I would check to see that she properly entered my handwritten notes into the Table Docket. Starting in February 2000, I began to input the dates directly into the Table Docket. The Table Docket did not automatically calculate due dates for prosecution matters, nor did the Table Docket automatically remove docket entries nor did it reset and/or recalculate deadlines. Docket entries such as due dates for responses and/or actions to be taken, were mentally calculated by me, and were manually entered into the Table Docket. Dates were generally not removed from the Table Docket, even after a response was filed or an action was taken. Accordingly, the docket did not always reflect the actual status of an application, i.e., the presence of a docket entry in the Table Docket did not necessarily mean that a response still needed to be filed or an action still needed to be taken.

11. Prior to February 2000, after I had checked the legal department's secretary's entries into the Table Docket, and had her make any corrections necessary, I would have the secretary print out either the entire Table Docket (if there were docket entries made to numerous Docket Reports), or, only the Docket Reports that had been updated (if only a few docket entries had been made to only a few Docket Reports). The secretary would then either: a) place the entire

printout of the Table Docket into a looseleaf binder which was stored alongside the basket described in paragraph 10 above, discarding the prior Table Docket contained in the looseleaf; or b) remove from the looseleaf all Docket Reports that had been updated, and place the updated Docket Reports into the looseleaf binder. At any given point, the entire Table Docket was contained in this looseleaf binder (in addition to being electronically stored on the secretary's computer. A photocopy of each hard copy printout of each updated monthly Docket Report containing the newly entered information was also provided to Mr. Fedus as they were printed. From February 2000 through April 2003 I undertook all of the foregoing steps performed by the secretary.

12. Docket Report(s) were given to Mr. Ron Fedus on at least a monthly basis. I did this by leaving a copy of the Docket Report(s) on Mr. Fedus's chair. While typically, I did not discuss with Mr. Fedus the entries on the Docket Report, I did routinely highlight with a yellow marker especially urgent deadlines which appeared on the Docket Report(s) I provided to him.

13. Space was tight at 575 Fifth Avenue, with no separate storage areas allocated for patent files. Space was also tight at 527 Madison, even though it was a larger space than 575 Fifth, and had a separate storage area with open shelving in which files could be stored. While some prosecution files were stored in this defined space, the bulk of the separate storage area at 527 Madison contained litigation files and papers. We did not have adequate drawer space in either location for all of the prosecution files, nor did we have enough separate storage space together with drawer spacer at 527 Madison to store all the prosecution files. I recall that some patent prosecution files were stored in drawers and in legal-sized transfiles in both offices, and both the drawers and the transfiles were often in physically high locations that were difficult to access.

This is not to say that files were randomly strewn about in disorderly fashion, but it was difficult to locate files and difficult to access them due to the cramped conditions. Nevertheless, on occasion, I would pull out files that needed responses, if I could locate and access them, and I would place those files on Mr. Fedus's chair as deadlines loomed. I would also have the legal department secretary scan Office Actions into WORD documents and make copies of any art cited by Examiners. For some cases, I drafted the skeletons of responses to Office Actions, adding text from the scanned Office Actions into the draft responses in order to make it easier for Mr. Fedus to reply to the Office Actions.

14. As noted in paragraph 10 above, it was not my routine to remove or cause the legal department's secretary to remove any docket entries from the Table Docket once a docket entry was entered into the Table Docket. As also noted in paragraph 10 above, it was not apparent from the Table Docket alone, or for that matter from the Docket Reports themselves whether a reply was in the process of being prepared, or in fact had been prepared, or had been prepared and mailed to the USPTO, or had not yet been prepared. Thus, one could not usually tell from the Table Docket and/or the Docket Reports alone whether a given application was pending or abandoned. I generally became aware of abandonment of an application upon my seeing a Notice of Abandonment issued by the USPTO in the aforescribed wire basket.

15. As noted in paragraphs 10 and 13 above, as the status of an application could not be determined solely from the Table Docket and/or Docket Reports, it was often necessary to pull out and review the actual patent prosecution files themselves in order to ascertain the status of an individual application. As also noted above, it was often hard to physically get to those files due to the cramped storage conditions

16. Mr. Fedus kept a "chron" file, which consisted of a large black three-ring looseleaf binder labeled as his Chron File, in which he placed copies of everything he had worked on in chronological order. When the Chron File looseleaf binder became full, he would transfer the looseleaf binder contents into soft cover binders, and those binders would be labeled as monthly chronologies, with labels bearing his name and the time frame of the papers contained in the binder. Those binders were stored, as best as I recall, in a separate storage area at 527 Madison Avenue; I do not recall where these binders were stored at 575 Fifth. At some point, his soft-covered chrons' were shipped offsite to Enzo's Farmingdale location. After the initial Orders to Show Cause issued in July 2008, Mr. Fedus and I made several trips to Farmingdale to see if we could find his chrons. We were not successful and could not locate them.

17. When a Notice of Abandonment came to my attention, my general practice was to docket it for revival at monthly intervals from the date of abandonment up until the one year anniversary date of the date of abandonment. I would also docket the application for revival utilizing the date of issuance of the Notice Of Abandonment as a starting date. Using the example set out in paragraph 10 above, if I received a Notice of Abandonment dated April 15, 1994 for failure to respond to an Office Action mailed on September 1, 1993, I (or the legal department's secretary, as instructed by me) entered in the Table Docket a revival date reminder on a monthly basis from the date of abandonment (which abandonment date was not expressly stated in the Notice of Abandonment). In the example at hand, I would have docketed the date of the issuance of the Notice of Abandonment, i.e., April 15, 1994 with a notation that the application was abandoned for failure to respond to NF Office Action which issued Sep. 1, 1993; Application abandoned as of December 1, 1993. I would have also docketed May 15, 1994 as: Revive, one month after issuance of 4/15/94 Notice of Abandonment; Application abandoned 12/1/93 for failure to

respond to 9/1/93 NF OA. Likewise, I would have docketed June 15, 1994 as: Revive, two months after issuance of 4/15/94 Notice of Abandonment; Application abandoned 12/1/93 for failure to respond to 9/1/93 NF OA. In addition to docketing from the date of the issuance of the notice of abandonment with entries for the subsequent two or three months, I would also have made docket entries calculated from the actual date of abandonment of the application, namely, I would have docketed an entry for May 1, 1994 as 5 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!. I would have docketed further as follows: a) June 1, 1994 as 6 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; b) July 1, 1994 as 7 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; c) August 1, 1994 as 8 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; d) September 1, 1994 as 9 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; e) October 1, 1994 as 10 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; f) November 1, 1994 as 11 months after NF OA application was abandoned on December 1, 1993 for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application!; and g) December 1, 1994 as 12 months after NF OA application was abandoned on December 1, 1993

for failure to respond to NF OA issued September 1, 1993, along with a notation to Revive the Application, with an additional notation as ABSOLUTELY LAST DAY TO REVIVE!!!.

18. After docketing, the papers from which the docket entry dates were extracted were placed in their respective files by me, or the legal department's secretary. It was not my practice to undertake any investigation as to the circumstances surrounding the abandonment of an application.

19. Sometime after attorney Natalie Bogdanos joined Enzo in April, 2003, I stopped docketing, and I continued with my other duties at Enzo, such as contract administration and drafting documents (including production distribution and licensing agreements, collaborative scientific research agreements, material transfer agreements, product testing and production agreements, confidentiality agreements (drafting, reviewing and negotiating individual, academic and corporate agreements with third parties under an attorney's direction), employment matters, including consulting and option agreements, reviewing real property leases for clinical lab services), litigation assistance, trademark matters, research, specialized database searches, and other diverse non-routine matters.

Discussion of Show Cause Order vis-à-vis the Present Application

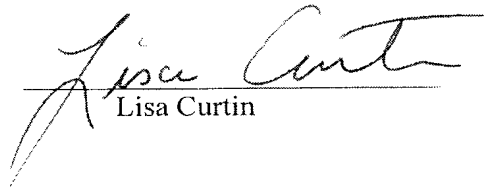
20. With respect to this application, copies of corresponding Docket Reports are attached in the form of a running docket log. The log includes a header for reference purposes, i.e., "J10012 DOCKET REPORT EXHIBIT p. 1-4". Specific Docket Report entries that are not relevant to the present application have been redacted and annotated with the letter designation nn. The

following Docket Report entries, which have been bolded for emphasis, are relevant to the present application, as indicated by Enzo's internal designation of "ENZ-53(C)":

- a) "5/20/02; ENZ-53(C) – FOA issues" (J10012 Docket Report Exhibit p. 1);
- b) "6/20/02; ENZ-53(C) – 1 mo. After 5/20/02 FOA" (J10012 Docket Report Exhibit p. 1);
- c) "7/20/02; ENZ-53(C) – 2 mo. After 5/20/02 FOA" (J10012 Docket Report Exhibit p. 2);
- d) "8/20/02; ENZ-53(C) – 3 mo. After 5/20/02 FOA" (J10012 Docket Report Exhibit p. 3);
- e) "9/20/02; ENZ-53(C) – 4 mo. After 5/20/02 FOA" (J10012 Docket Report Exhibit p. 3);
- f) "10/20/02; ENZ-53(C) – 5 mo. After 5/20/02 FOA" (J10012 Docket Report Exhibit p. 3);
- g) "11/20/02; ENZ-53(C) – 6 mo. After 5/20/02 FOA" (J10012 Docket Report Exhibit p. 4);
- h) "1/31/01; Enz-53(C) – Notice of Abandonment issued" (J10012 Docket Report Exhibit p. 4).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

August 7, 2009


Lisa Curtin